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EXAMINER

POPHAM, JEFFREY D

| ART UNIT | PAPER NUMBER |
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2137

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,113

Applicant(s)

KING, JAMES E. ET AL.

Examiner

Jeffrey D. Popham

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20030903, 20031010</u> . | 6) <input type="checkbox"/> Other: ____. |

Remarks

Claims 1-31 are pending.

Drawings

1. The drawing are objected to as failing to comply with 37 CFR 1.84(p)(4) and 1.84(p)(5) because of the following problems:
 - Figure 3: 24', 26', and 32' are not mentioned in the spec.
 - Figure 5: 85 is not mentioned in the spec.
 - Figure 6: 85 is not mentioned in the spec.
 - Figure 7: 85 should be 100.
 - Figure 9: 162 is not mentioned in the spec.
 - Figure 10: 189 is not mentioned in the spec.
 - Figure 12: 06 should be 306.
 - Figure 13: 142 should be 342 and 144 should be 344.
 - Figure 15: 492 should be 491.
 - Figure 15: 440, 480, and 482 are not mentioned in the spec.
 - Figure 16: 80, 475, 476, 477, 482, 499, 472, 474 are not mentioned in the spec.
 - Figure 17: 500, 540, 12 should be 512.
 - In the Specification, page 32, line 2: reference numeral 40 should be 440.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 2, 3, 11, 12, 21, and 22 are objected to under 37 CFR 1.75(a) because of the following informalities:

- Claim 2, line 6; claim 11, line 7; and claim 21, line 7 recite the limitation "the data carrier". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejection, it has been construed as "a data carrier".
- Claim 2, line 7; claim 11, line 7; and claim 21, line 7 recite the limitation "the second memory location". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejection, it has been construed as "a second memory location".

- Claim 3, line 1; claim 12, line 1; and claim 22, line 1 recite the limitation "the access control logic". There is insufficient antecedent basis for this limitation in the claims. For purposes of prior art rejection, it has been construed as "access control logic".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 10, 13, 15, 20, 23, 25, 26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al. (U.S. Patent Application 08/876,144) in view of Walters (U.S. Patent 5,357,573).

Regarding Claim 1,

Martineau et al. disclose a processing unit connectable to a data communications network, the processing unit having a device reader (Page 13, lines 21-22) for a portable storage device that includes storage operable to supply a network identity (Page 14, lines 23-25) for the processing unit and an access controller (Page 16, lines 21-24), the access controller being operable to prevent unauthorized reading and

writing to the storage (Page 16, lines 21-24), the processing unit being operable to read the supplied network identity only after authentication has taken place (Page 16, line 21 to Page 17, line 1; and Page 17, lines 8-10). Martineau et al. do not disclose the method of first attempting to write to the storage device and, only once the write has failed, to read the network identity.

Walters, however, discloses that the processing unit is operable, before reading from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read data identifying the computer system that the card is supposed to be used with (Column 4, line 62 to Column 5, line 21). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the memory card of Walters into the smart card system of Martineau et al. in order to verify that the card input to the system was an approved card that could be used with the system.

Regarding Claim 10,

Claim 10 is a program claim that corresponds to system claim 1 and is rejected for the same reasons.

Regarding Claim 15,

Claim 15 is a program on carrier medium claim that corresponds to system claim 1 and is rejected for the same reasons.

Regarding Claim 20,

Claim 20 is a method claim that corresponds to system claim 1 and is rejected for the same reasons.

Regarding Claim 25,

Claim 25 is a system claim that is broader than system claim 1 and is rejected for the same reasons.

Regarding Claim 26,

Claim 26 is a system claim that is broader than system claim 1 and is rejected for the same reasons.

Regarding Claim 4,

Martineau et al. disclose that the portable storage device is a smart card (Page 13, lines 21-22), the access controller is a microcontroller or microprocessor (Page 20, lines 15-22), and the device reader is a smart card reader (Page 13, lines 21-22; and Page 15, line 25 to Page 16, line 3).

Regarding Claim 13,

Claim 13 is a program claim that corresponds to system claim 4 and is rejected for the same reasons.

Regarding Claim 23,

Claim 23 is a method claim that corresponds to system claim 4 and is rejected for the same reasons.

Regarding Claim 30,

Claim 30 is a system claim that is broader than system claim 4 and is rejected for the same reasons.

Regarding Claim 29,

Martineau et al. disclose that the access controller is a microcontroller (Page 20, lines 15-22).

4. Claims 2, 11, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al. in view of Walters, further in view of Braithwaite et al. (U.S. Patent 5,644,444).

Regarding Claim 2,

Martineau et al. disclose copying the supplied network identity from a data carrier to a second memory location and to use the supplied network identity (Page 14, lines 23-25; and Page 16, lines 21-24).

Martineau et al. do not disclose attempting a write, then reading, or the detection of a portable storage device upon powering up of the processing unit.

Walters, however, discloses attempting a write to the storage of the portable storage device, and on determining that the write has failed, to copy data from the device (Column 4, line 62 to Column 5, line 21). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the memory card of Walters into the

smart card system of Martineau et al. in order to verify that the card input to the system was an approved card that could be used with the system.

Walters does not disclose the detection of a portable storage device upon powering up of the processing unit.

Braithwaite et al., however, disclose that the processing unit is operable, on being powered up, to determine whether a said portable storage device is present in the device reader (Column 9, lines 30-41). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the write protection scheme of Braithwaite et al. into the smart card system of Martineau et al. as modified by Walters in order to properly detect a portable storage device so as to continue operations without delay.

Regarding Claim 11,

Claim 11 is a program claim that corresponds to system claim 2 and is rejected for the same reasons.

Regarding Claim 21,

Claim 21 is a method claim that corresponds to claim 2 and is rejected for the same reasons.

5. Claims 3, 12, 22, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al. in view of Walters, further in view of Hellman et al. (U.S. Patent 4,200,770).

Regarding Claim 3,

Martineau et al. disclose that the processing unit is operable to modify the content of the portable storage device on the condition that proper authentication and encryption have taken place (Page 16, line 21 to Page 17, line 1). Martineau et al. do not disclose key exchange or key-to-key encryption.

Hellman et al. disclose key-to-key encryption (Column 8, line 65 to Column 9, line 25) and a key exchange method comprising a transmitter that supplies a key to a receiver (Column 9, lines 7-8), and, in response to receipt of a return key from the receiver (Column 9, line 9-10), to send an encrypted message to the receiver (Column 9, lines 20-23). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the key exchange and encryption schemes of Hellman et al. into the smart card system of Martineau et al. as modified by Walters because Martineau et al. disclose that any convenient or conventional encryption scheme may be used in the system (Page 16, line 25 to Page 17, line 1; and Page 17, lines 8-10).

Regarding Claim 12,

Claim 12 is a program claim that corresponds to system claim 3 and is rejected for the same reasons.

Regarding Claim 22,

Claim 22 is a method claim that corresponds to system claim 3 and is rejected for the same reasons.

Regarding Claim 27,

Claim 27 is a system claim that is broader than system claim 3 and is rejected for the same reasons.

Regarding Claim 28,

Martineau et al. disclose that the access controller is subsequently operable to respond to an encrypted command from the processing unit to modify the content of the storage in the portable storage device (Page 16, lines 21-24).

6. Claims 5, 14, 24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al. in view of Walters, further in view of "Windows NT Server".

Regarding Claim 5,

Martineau et al. as modified by Walters does not disclose a MAC address.

"Windows NT Server", however, discloses that the network identity comprises a MAC address (Page 12, Paragraphs 2 and 3). It would have been obvious to one of ordinary skill in the art to combine the ARP protocol of "Windows NT Server" with the smart card system of Martineau

et al. as modified by Walters in order to obtain the (physical) MAC address of a computer from the (logical) IP address of that computer.

Regarding Claim 14,

Claim 14 is a program claim that corresponds to system claim 5 and is rejected for the same reasons.

Regarding Claim 24,

Claim 24 is a method claim that corresponds to system claim 5 and is rejected for the same reasons.

Regarding Claim 31,

Claim 31 is a system claim that is broader than system claim 5 and is rejected for the same reasons.

7. Claims 6, 7, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al. in view of Walters, further in view of Combaluzier (U.S. Patent 5,973,475).

Regarding Claim 6,

Martineau et al. disclose that the processing unit comprises circuitry to allow the processing unit to control functions of the processing unit (Page 14, lines 18-22), but do not disclose that the circuitry is a service processor.

Combaluzier, however, discloses that the processing unit comprises a service processor, the service processor being programmed

to control reading of the portable storage device (Column 4, lines 22-33).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the cellular telephone of Combaluzier into the smart card system of Martineau et al. as modified by Walters in order to identify the user and authorize the use of the cellular telephone, as well as perform any needed transferring of data between the portable storage device and the processing unit (Column 4, lines 34-55).

Regarding Claim 16,

Claim 16 is a program claim that corresponds to system claim 6 and is rejected for the same reasons.

Regarding Claim 7,

Martineau et al. as modified by Walters does not disclose that the service processor is a microcontroller.

Combaluzier, however, discloses that the service processor is a microcontroller (Column 4, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the cellular telephone of Combaluzier into the smart card system of Martineau et al. as modified by Walters in order to identify the user and authorize the use of the cellular telephone, as well as perform any needed transferring of data between the portable storage device and the processing unit (Column 4, lines 34-55).

Regarding Claim 17,

Claim 17 is a program claim that corresponds to system claim 7 and is rejected for the same reasons.

Regarding Claim 18,

Martineau et al. as modified by Walters does not disclose that the program is run on a microprocessor.

Combaluzier, however, discloses that the microprocessor controls the operations of the processing unit (Column 4, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the cellular telephone of Combaluzier into the smart card system of Martineau et al. as modified by Walters in order to identify the user and authorize the use of the cellular telephone, as well as perform any needed transferring of data between the portable storage device and the processing unit (Column 4, lines 34-55).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al. in view of Walters, further in view of Teppler (U.S. Patent 6,792,536).

Martineau et al. as modified by Walters does not disclose that the processing unit is a server.

Teppler, however, discloses that the processing unit is a server computer (Column 14, lines 32-37; and Column 20, lines 7-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the smart card system of Teppler into the smart card system of

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Martineau et al. as modified by Walters in order to provide much interoperability and to ensure that secure messaging is done within a protected server security parameter.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al. in view of Walters, further in view of Hastings et al. (U.S. Patent 5,460,441).

Martineau et al. as modified by Walters does not disclose that the processing unit is a rack mountable computer server.

Hastings et al., however, disclose that the processing unit is a rack mountable computer server (Column 3, line 48 to Column 4, line 17). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the server rack system of Hastings et al. into the smart card system of Martineau et al. as modified by Walters in order to have the server(s) disposed in a unique manner so as to provide substantially improved access thereto.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martineau et al. in view of Walters and Combaluzier, further in view of Teppler.

Martineau et al. as modified by Walters does not disclose that the processing unit is a server or that the microcontroller is operable as a service processor.

Teppler, however, discloses that the processing unit is a server computer (Column 14, lines 32-37; and Column 20, lines 7-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the smart card system of Teppler into the smart card system of Martineau et al. as modified by Walters in order to provide much interoperability and to ensure that secure messaging is done within a protected server security parameter.

Teppler does not disclose that the microcontroller is operable as a service processor.

Combaluzier, however, discloses that the microcontroller is operable as a service processor and connected to read the content of storage in a portable storage device mounted in the portable storage device (Column 4, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the cellular telephone of Combaluzier into the smart card system of Martineau et al. as modified by Walters in order to identify the user and authorize the use of the cellular telephone, as well as perform any needed transferring of data between the portable storage device and the processing unit (Column 4, lines 34-55).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Andrew Caldwell". The signature is stylized with a large, looped "C" at the end.

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER